

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussions, is respectfully requested.

Claims 1-3, 5-7, 11-13 and 15-30 are currently pending in the application. Claims 4, 8-10 and 14 have been canceled; Claims 2 and 5 have been amended, and Claims 15-30 have been added herewith. The changes to the claims are supported by the originally filed specification and do not introduce any new matter. For example, see paragraph [0038] for support for claims 18, 24 and 27. See also paragraphs [0026] –[0032] for support for claims 28-30.

In the outstanding Office Action, the specification was objected to; claims 4, 8-10 and 14 were objected to because of informalities; and claims 1-3, 5-7 and 11-13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Voit (U.S. Patent No. 6,104,711 (hereinafter “the ‘711 patent”)) in view of Dean et al. (U.S. Patent No. 6,223,292 (hereinafter “the ‘292 patent”)).

In response to the objection of the specification, the specification has been amended to capitalize the trademark WINDOWS and to include the use of the generic phrase “operating system” thereafter. Thus, this ground for objection has been overcome.

In response to the objection to claims 4, 8-10 and 12, it is respectfully submitted that such claims have been canceled to obviate this ground for objection and facilitate prosecution. However, similar limitations have been added in the newly added claims. It is further noted that failure to have examined those claims in the first office action is impermissible and not in compliance with PTO procedure. Those claims are originally filed claims and constitute their own description for the purposes of compliance with the written description requirement of 35 USC 112, first paragraph. It is respectfully submitted that any attempt to read those claims to be limited by the disclosure of paragraph [0040] is

inconsistent with existing case law. In light of the partial examination of this application, Applicant requests that a new, non-final action be issued as a next office action if a notice of allowance is not issued instead.

In response to the rejection of claims 1-3, 5-7 and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over the '711 patent in view of the '292 patent, that ground for rejection is respectfully traversed. Claim 1 recites:

a first computer code device configured to obtain an identifier corresponding to electronic information being displayed to a user;
a second computer code device configured to convert the identifier into a telephone number corresponding to a location at which a provider of the electronic information can be contacted.

The Office Action admits that the '711 patent fails to "teach obtaining an identifier that corresponds to the electronic information," but attempts to overcome this admitted deficiency by relying on the teachings of the '292 patent. However, such reasoning overlooks evidence there is no motivation to combine (and modify) the cited references as suggested by the Office Action.

There is no motivation to combine the cited references since to do so one would have to modify the teachings of at least one of the '292 and '711 patents. As admitted by the Office Action, the '292 patent describes obtaining a Uniform Resource Locators (URL) of a document, not just its domain name.¹ However, the '711 patent is directed to domain name translations, and does not describe what, if anything, to do with the other two parts of the URL not used by the '711 patent. Moreover, even if the identifier were a URL, as in claim 2, the Office Action still does not provide a prima facie case of obviousness for the claims since the '711 patent does not describe using a URL, but only a portion thereof. The Office Action has not cited any rationale supporting such a modification (or even recognized the existence

¹ See attached definitions of "URL" from Webopedia.com, hyperdictionary.com, and whatis.techtarget.com, each describing that a URL is composed of three parts – a protocol, a server's domain name or IP address, and a resource (or document name) available at the specified server using the specified protocol.

of such a modification) and, therefore, is impermissible. See In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992) (“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious ‘modification’ of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”) (citing ACS Hosp. Systems, Inc. v. Montefiore Hosp., 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (citations omitted)).

Claim 1 is also patentable in light of the fact that the modification of the ‘711 patent proposed by the examiner was clearly possible at the time of the filing of the ‘711 patent, but even the inventor listed on the ‘711 patent did not see the potential or need for such a change. The World Wide Web was in use in March, 1997 when Voit filed his patent application, but the ‘711 patent does not describe tracking a relationship between displayed information and the provider thereof. This omission is the strongest evidence that shows that the combination/modification proposed by the Office Action is not obvious.

Moreover, the ‘711 patent and the present invention are directed to different problems. The ‘711 patent focuses on user-centric computing in which a first person wants to communicate by telephone number or email to a second person whose identity is already known to the first person (e.g., “eric.vot@phone” or “301-608-2908@phone”). By contrast, the present invention is directed to data-centric computing where the first person knows what information he/she is looking at, but has no way to relate that to a contact person. To change from user-centric to data-centric would require a modification in the principle of operation of

the '711 patent. As such, there is no motivation for making the modification as would be necessary to support the Office Action's proposed combination.

For the reasons set forth above, it is respectfully submitted that claim 1, and its dependent claims 2, 3 and 18, are patentably distinguishing over the cited combination of references (and their required modifications). Independent claims 5, 11, 15, 19 and 25 recite similar limitations to the limitations discussed above with respect to claim 1. Thus, those claims (and their corresponding dependent claims) should be patentable for reasons analogous to the reasons set forth above for the patentability of claim 1.

New claims 18, 24 and 27 have also been added herewith. Claim 18, which is representative of those new claims, recites "visually identifying to a user, without a user request, that a second identifier is known for the electronic information being displayed to the user." The cited combination of references does not render obvious such a positively recited limitation as the '711 patent, being user-centric, would have no way to know which person the user would want to get contact information for since the '711 patent does not have the concept of tying the contact information to the displayed information.

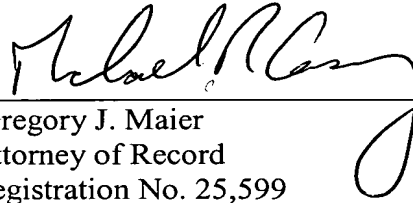
New claims 28-30 have also been added herewith. Claim 28, which is representative of those new claims, recites "obtain[ing] the second identifier by finding a longest matching sub-string in a database without requiring the whole document name to be found in the database." No such teaching has been asserted as being present in either of the '711 and '292 patents. Thus, those claims should be separately patentable.

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Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome and in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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